

I. Overview of the Amendments.

1. To the Specification.

The amendments to the specification are presented herein below (after the signature page) in the section titled “Amendments to the Specification.”

The amendment to page 16, lines 26-32 is being made to correct a typographical error.

The amendments to Table 2 on pages 18-19 introduce the appropriate SEQ ID NOS into the table.

Accordingly, no new matter has been added by way of these amendments and the entry thereof is respectfully requested.

2. To the Claims.

Claims 6-19 are pending in the application. Claims 6-10 are canceled without prejudice or disclaimer. Claims 11-19 are amended without prejudice or disclaimer.

Applicants expressly reserve the right to bring the subject matter of the original claims again in a subsequent, related application. New dependent claims 23-32 are added by this amendment. After entry of this amendment claims 11-19 and 23-32 are pending.

The amendments to the claims are presented herein below (after the signature page) in the section titled “Amendments to the Claims.”

Applicants note that the amendments regarding the recombinant adenovirus made to independent claims 11 and 14 correspond to the limitations recited in the issued claims of the parent application (now U.S. Patent No. 6,635,244) of the present application. Further, the following dependent claims correspond in scope to the issued dependent claims in U.S. Patent No. 6,635,244, with regard to the limitations relative to the recombinant adenovirus:

Claims in U.S. Patent No. 6,635,244	Claims in Present Application
1	11, 14
2	13
3	25
4	26
5	16, 17, 27

Claims in U.S. Patent No. 6,635,244	Claims in Present Application
6	28, 30

Support for the amendments to claims 11 and 14 can be found throughout the specification, for example, at the following locations: page 3, line 31, to page 4, line 9; page 6, lines 11-13; page 6, line 14, to page 7, line 2; page 12, lines 10-20; and Examples 1-3.

Claims 12, 15, 16, 17, and 19 are amended to provide consistent phrasing for the dependent claims.

Claim 13 is amended to provide consistent phrasing for the dependent claim, as well as to correct the language of the Markush group. Further, the dependency of claim 13 is amended.

Claim 18 is amended to remove the multiply dependent language. Amended claims 18 and 23 correspond to original claim 18.

Support for newly presented claims 23, 31, and 32 can be found throughout the specification, for example, at the following location: pages 16-17.

Support for newly presented claims 24 and 29 can be found throughout the specification, for example, at the following location: page 17, lines 3-5.

Support for newly presented claims 25 and 26 can be found throughout the specification, for example, at the following location: page 22, lines 6-7.

Support for newly presented claim 27 can be found throughout the specification, for example, at the following location: page 20, lines 6-7.

Support for newly presented claims 28 and 30 can be found throughout the specification, for example, at the following location: page 22, lines 10-32.

Accordingly, no new matter has been added by way of these amendments and the entry thereof is respectfully requested.

II. Response to Restriction Requirement

In the Restriction Requirement dated 2 March 2006, the Examiner required election of one of the following groups of claims:

Group I. Claims 9 and 10, drawn to a polynucleotide comprising an adenovirus with

a single mutation in the E1B-55K gene that is ONYX 051;

Group II. Claims 9 and 10, drawn to a polynucleotide comprising an adenovirus with a single mutation in the E1B-55K gene that is ONYX 053;

Group III. Claims 6 and 7, drawn to an isolated E1B-55K protein with a single mutation at position 240;

Group IV. Claims 6 and 8, drawn to an isolated E1B-55K protein with a single mutation at position 240 [*sic*], applicants believe the Examiner intended position 260;

Group V. Claims 11, 12, 14-16, 18 and 19, drawn to a method of treating cancer in a patient by administration of an adenovirus comprising a single mutation in the E1B-55K protein that is ONYX 051, applicants believe the Examiner intended to include claim 13 in this group as the claim recites both ONYX 051 and ONYX 053; and

Group VI. Claims 11, 13, 14, 15, 17-19, drawn to a method of treating cancer in a patient by administration of an adenovirus comprising a single mutation in the E1B-55K protein that is ONYX 053, applicants believe the Examiner intended to include claim 12 in this group.

Applicants note that the claims of Groups V and VI, as set forth by the Examiner, include not only claims to “A method of treating cancer in a patient in need of said treatment, comprising administering to said patient a dose of a recombinant adenovirus” (e.g., claim 11) but also claims to “A method of treating cancer in a patient in need of said treatment, comprising administering to said patient a dose of an isolated polynucleotide” (e.g., claim 14).

Applicants have amended independent claims 11 and 14 to contain limitations corresponding to the limitations associated with the recombinant adenovirus in the issued claims of the parent U.S. Patent No. 6,635,244. By doing so, claims 11 and 14 now represent genus claims of which ONYX 051 and ONYX 053, as well mutated E1B-55K proteins comprising a single amino acid mutation in amino acid 240 or 260 are species. Accordingly, applicants respectfully request rejoinder of the claims of Groups V and VI. Applicants submit that, in view of the fact that the recombinant adenovirus has already been found by the Examiner to constitute patentable subject matter, no undue search burden is placed on the Examiner by rejoinder of these claims into a single Group. Applicants submit that it is

reasonable for the Examiner to begin prosecution with examination of claims using ONYX 051 as an initial species. Applicants submit that this election of species is for the purposes of preliminary search and examination only, and that upon allowance of a generic claim, applicants will be entitled to consideration of claims to the additional species.

Regarding applicants' formal election in response to the Restriction Requirement, applicants hereby elect to prosecute the claims of Group V, claims 11, 12, 13-16, 18 and 19, with traverse. Applicants traverse is set forth herein above. Applicants expressly reserve their right under 35 USC §121 to file one or more divisional applications, during the pendency of this application, directed to the non-elected subject matter.

III. Information Disclosure Statement.

Accompanying this response is an Information Disclosure Statement (IDS) and a modified form 1449. The IDS includes a modified form 1449 copies of the cited references are of record in parent application USSN:09/918,696, now U.S. Patent No. 6,635,244, with the exception that U.S. Patent Nos. 6,635,244 and 6,080,578 are listed on the modified form 1449. Accordingly, new copies of the cited references are not being provided (see, 37 C.F.R. §1.98(d)). Further, copies of U.S. Patent Nos. 6,635,244 and 6,080,578 are not being provided as they are U.S. Patent publications. Applicants request that the Examiner indicate that the references have been considered by initialing each cited reference on the modified form 1449 and returning a copy of the initialed form to the applicants. No fee is believed due as the IDS is being submitted before any substantive action on the claims.

Conclusion

Applicants respectfully submit that the claims comply with the requirements of 35 U.S.C. §112 and define an invention that is patentable over the art. Accordingly, a Notice of Allowance is believed in order and is respectfully requested.

Please direct all further communications in this application to:

Gregory Giotta, Ph.D., Esq.
(Reg. No. 32,028)
ONYX Pharmaceuticals, Inc.
2100 Powell Street
Emeryville, CA 94608
Phone: (510) 597-6502
Facsimile: (510) 597-6610.

If the Examiner notes any further matters that the Examiner believes may be expedited by a telephone interview, the Examiner is requested to contact Gregory Giotta at (510) 597-6502.

Respectfully submitted,

Date: 3 Apr 2006

By: Gary R. Fabian
Gary R. Fabian, Ph.D.
Registration No. 33,875
Agent for Applicants